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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 14

Application Number: 09/192,583
Filing Date: 11/17/98
Appellant(s): Tetsuro Motoyama

Gregory J. Maier
__For Appellant__

EXAMINER'S ANSWER

MAILED
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Technology Center 2100

This is in response to appellant's brief on appeal filed 12/21/01.

(1)   *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2)   *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3)   *Status of Claims*

This appeal involves claims 1-53.

(4)   *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5)   *Summary of Invention*

The summary of invention contained in the brief is correct.

(7)   *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 2-17, 45-48 stand or fall together, claims 18, 19-22, 49 stand or fall together, claims 23, 24-39, 50-52 stand or fall together, claims 40, 41-44, 53 stand or fall together.

(8)   *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

6,065,136	Kuwabara	05/16/00
6,023,723	McCormick et al.	02/08/00
6,073,166	Forse'n	06/06/00
6,003,070	Frantz	12/14/99
6,108,492	Miyachi	08/22/00

(10)   *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 2, 3, 8, 12-17, 20, 23-25, 34, 35, 36, 37-39, 42, 45, 46, 48, 50, 51, 52 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwabara (U.S.Patent

No.6,065,136) in view of McCormick et al. (U.S.Patent No.6,023,723).

In the claim 1, Kuwabara discloses a program for trouble shooting inspection is set in

the form of electronic mail by the mail setting program and to User A through the Internet

communication from the trouble diagnosing computer ; comprising:

♦   receiving an electronic mail message by a computer (Computer C1);

♦   determining whether the message which has been received is for a device (Main part 11)

associated with the computer (Computer C1) (see figure 1, figure 2, , col.5, lines 65-67,

col.6, lines 1-22);

♦   transmitting a communication from the computer (Computer C1) to the device (Main Part

11), when the step of determining determines that the message is for the device (Main

Part 11) (see figure 1, figure 2, col.5, lines 65-67, col.6, lines 1-22, col.4, lines 33-34).

However, Kuwabara does not disclose determining whether the message which has been

received is for a device associated with the computer by detecting a characteristic of the e-mail,

the device being a business office device including a processor.

McCormick et al. discloses determining whether the message which has been received is

for a device (computer) associated with the computer (a system of filtering e-mail) by detecting a

characteristic of the e-mail, the device being a business office device (computer) including a

processor(see abstract, a filter is provided including character strings which the user wishes to

receive, see figure 2).

Given the teaching of McCormick, it would have been obvious to one of ordinary skill in

the art at the time of the invention to have Kuwabara's system detect characteristic of the e-mail

in order to automatically detect email directed to control of business office device because it

would have enable automated remote diagnostic of the business machine via electronic mail

message.

3.   In the claim 2, Kuwabara discloses determining whether the message which has been received is for the device or whether the message which has been received has been received has a user of the computer as an end recipient (see col.5, lines 65-67, col.6, lines 1-22).

4.   In the claim 3, Kuwabara discloses displaying, after the receiving step, a message to the user indicating the electronic mail message contains information to be forward to the device, wherein the determining step comprises: determining by a user reading the message which has been displayed, whether the message which has been received is for the device (see col.5, lines 65-67, col.6, lines 1-22).

5.   In the claim 8, Kuwabara discloses receiving an Internet electronic mail message (see col. 6, lines 13-16).

6.   In the claims 12, 34, Kuwabara discloses determining that the message is for a device automatically by detecting a characteristic of the email (see col.6, lines 1-17).

7.   In the claims 13, 35, Kuwabara discloses determining that the message is for a device automatically by detecting a code within the message (see col.6, lines 1-35).

8.   In the claims 14, 15, 36, 37, Kuwabara discloses determining that the message is for a device automatically by detecting the code which is the subject of the message (see col.5, lines 10-20, col. 6, lines 1-35).

9. In the claims 16, 38, Kuwabara discloses the determining step is performed in response to a receipt of an incoming electronic mail message (see col.5, lines 50-67, col.6, lines 1-3).

10. In the claims 17, 39, Kuwabara discloses the determining step is performed in response to

a receipt of an incoming electronic mail message which is detected by monitoring an existence of

a file stored at a predetermined location in memory (see figures 3-4, col.5, lines 50-67, col.6,

lines 1-3).

11. In the claims 20, 42, Kuwabara discloses the computer is a message transfer agent, the step

of transmitting information from the device transmits the information from the device directly to

the computer which is the message transfer agent, and the step of transmitting the electronic mail

message transmits the electronic mail message using a TCP connection from the computer which

is a message transfer agent (see col.5, lines 1-67, col.6, lines 1-3).

12. In the claim 23, Kuwabara discloses a program for trouble shooting inspection is set in the

form of electronic mail by the mail setting program and to User A through the Internet

communication from the trouble diagnosing computer ; comprising:

♦ receiving an electronic mail message by a computer (Computer C1);

♦ determining whether the message which has been received is for a device (Main part 11)

associated with the computer (Computer C1) (see figure 1, figure 2, , col.5, lines 65-67,

col.6, lines 1-22);

♦ transmitting a communication from the computer (Computer C1) to the device (Main Part

11), when the step of determining determines that the message is for the device (Main

Part 11) (see figure 1, figure 2, col.5, lines 65-67, col.6, lines 1-22, col.4, lines 33-34).

However, Kuwabara does not disclose determining whether the message which has been received is for a device associated with the computer by detecting a characteristic of the e-mail, the device being a business office device including a processor.

McCormick et al. discloses determining whether the message which has been received is for a device (computer) associated with the computer (a system of filtering e-mail) by detecting a characteristic of the e-mail, the device being a business office device (computer) including a processor(see abstract, a filter is provided including character strings which the user wishes to receive, see figure 2).

Given the teaching of McCormick, it would have been obvious to one of ordinary skill in the art at the time of the invention to have Kuwabara's system detect characteristic of the e-mail in order to automatically detect email directed to control of business office device because it would have enable automated remote diagnostic of the business machine via electronic mail message.

13.   In the claim 24, Kuwabara discloses determining whether the message which has been received is for the device or whether the message which has been received has been received has a user of the computer as an end recipient (see col.5, lines 1-67, col.6, lines 1-3).

14.   In the claim 25, Kuwabara discloses for displaying a message to the user indicating the electronic mail message contains information to be forwarded to the device, wherein the means for determining comprises: means for determining , by a user reading the message which has

been displayed whether the message which has been received is for the device (see col.5, lines 1-67, col.6, lines 1-3).

15.   In the claims 45, 50, Kuwabara discloses receiving data from the device, in response to the step of operating the processor; creating an electronic mail message by the computer including the data which has been received; and transmitting over the Internet the electronic mail message generated by the computer (see figure 1-2, col.5, lines 1-67, col.6, lines 1-3).

16.   In the claims 46, 51, Kuwabara discloses executing, by a device driver of the computer, commands for at least one of controlling and monitoring the device (see figure 1-2, col.5, lines 1-67, col.6, lines 1-3).

17.   In the claims 48, Kuwabara discloses transmitting the communication as a command for processing by the processor of the device (see figure 1-2, col.5, lines 1-67, col.6, lines 1-3).

18.   In the claim 52, Kuwabara discloses means for transmitting the communication as a command for processing by the processor of the device (see figure 1-2, col.5, lines 1-67, col.6, lines 1-3).

19.   Claims 4, 5, 6, 7, 9,. 26, 27, 28, 29, 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system of Kuwabara - McCormick in view of Forse'n (U.S.Patent No.6,073,166).

        In the claims 4, 26, the combined system of Kuwabara and of McCormick discloses the substantial features as limitations of claim 3.

However, the combined system of Kuwabara and of McCormick does not disclose

executing a command which causes the step of transmitting to be performed.

Forse'n discloses module of executable code is derivable automatically for automatically

starting the execution thereof together with the associated data when Internet Mail is read;

comprising:

♦   executing a command which causes the step of transmitting to be performed.(see col.1,

     lines 10-24, lines 10-24, lines 30-35, col.2, lines 27-30, col.3, lines 1-2, lines 30-31, lines

     42-45).

Given the teaching of Forse'n, it would have been obvious to one of ordinary skill in the

art at the time of the invention to modify the combined system of Kuwabara and of McCormick

to execute a command which causes the step of transmitting to be performed. because E-mail

messages transmit from the computer which is attached to the device which include information

regarding the status or capabilities of the device. Therefore, the attached file is an executable file

which allows a user A ("clicking" or "double-clicking") to execute the program code contained

within the attached file.

20.   In the claims 5, 27, Forse'n discloses executing program code of a file which is attached

to the message by a manual action by the user (see col.3, lines 30-32).

21.   In the claims 6, 28, Forse'n discloses executing the program code of the file by pointing,

using a pointing device and a graphical user interface, to an object representing the file (see col.3,

lines 30-32).

22.   In the claims 7, 29, Forse'n discloses executing the code by pressing a button while pointing to the object representing the file (see figure 3, col.3, lines 30-38).

23.   In the claim 9, Kuwabara discloses the step or executing a command comprises transmitting information to a device driver executing within the computer; and the step of transmitting is performed using device driver (see figure 1, figure 2, col.2, lines 29-31, col.5, lines 65-67, col.6, lines 1-22).

24.   In the claim 30, Kuwabara discloses the means for receiving an Internet electronic mail message (see col.5, lines 1-67, col.6, lines 1-3).

25.   In the claim 31, Kuwabara discloses the means for executing a command comprises means for transmitting information to a device driver executing within the computer; and the means for transmitting operates using the device driver (see figures 1-2, User A-C or Users 1-3, col.5, lines 1-67, col.6, lines 1-3).

26.   Claims 10, 11, 21, 22, 32, 33, 43, 44, 47, 49, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system of Kuwabara - McCormick in view of Miyachi (U.S.Patent No 6,108,492).

In the claims 10, 32, 45, the combined system of Kuwabara and of McCormick discloses the substantial features as limitations of claim 1.

However, the combined system of Kuwabara and of McCormick does not disclose receiving, by the device, the communication transmitted from the computer; and transmitting

parameters from the device to the computer, in response to the communication which has been received by the device.

Miyachi discloses the present invention relates generally to method of scheduling and facilitating maintenance and repair of electronic equipment, more particular to devices use multifunction peripherals (printer, scanner, fax-data-voice (FDV) modem) which have advanced self-monitoring capabilities; comprising:

♦ receiving, by the device, the communication transmitted from the computer; and transmitting parameters from the device to the computer, in response to the communication which has been received by the device (see abstract, col.1, lines 65-67, col.2, lines 1-5, lines 25-35, col.3, lines 40-50, col.8, lines 60-67, col.9, lines 25-34, lines 40-47, col.10, lines 5-7, lines 28-67).

Given the teaching of Miyachi, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Kuwabara and of McCormick to receiving, by the device, the communication transmitted from the computer, and transmitting parameters from the device to the computer, in response to the communication which has been received by the device because it would have enable troulbe diagnosing computer to know status information of devices before remoting dignostic of the business office devices.

27. In the claims 11, 33, Miyachi discloses performing a mechanical action by the device, in response to the communication which has been received by the device (see col.3, lines 35-50, lines 60-67, col.8, lines 65-67, col.9, lines 25-35, lines 40-47, col.10, lines 5-7, lines 28-67).

28.   In the claims 21, 43, Miyachi discloses creating a file corresponding to the information;

and writing the file to database directory of the computer, and wherein the step of transmitting

the message comprises transmitting the message corresponding to the information using the file

stored in the database directory (see col.1, lines 65-67, col.2, lines 1-10, lines 25-35, col.3, lines

35-67, col. 5, lines 5-8, col.8, lines 60-67, col.9, lines 25-34, lines 40-47, col.10, lines 5-7, lines

28-67).

29.   In the claim 22, 44, Miyachi discloses creating and writing comprises creating a plurality

of files and writing the plurality of files in the database directory; and the step of transmitting

comprises transmitting the message using each of the plurality of files stored in the database

directory (see col.1, lines 65-67, col.2, lines 1-10, lines 25-35, col.3, lines 35-67, col. 5, lines 5-8,

col.8, lines 60-67, col.9, lines 25-34, lines 40-47, col.10, lines 5-7, lines 28-67).

30.   In the claims 47, 49, 53, Miyachi discloses wherein the business office device at least

one of generates an image on a recording medium and scans an image on a recording medium

(see col.2, lines 27-35).

31.   Claims 19, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the

combined system of Kuwabara - McCormick..

In the claims 19, 41, the combined system of Kuwabara and of McCormick discloses the

substantial features as limitations of claim 18.

However, the combined system of Kuwabara and of McCormick does not disclose

transmitting the information from the device driver to a message application programming

interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step

of transmitting the electronic mail message comprises transmitting mail message corresponding

to the information which has been processed by the MAPI.

It would have been obvious to modify the combined system of Kuwabara and of

McCormick by employing message application program interface (MAPI) of the computer, and

processing the information by the MAPI, wherein the step of transmitting the electronic mail

message comprises transmitting mail message corresponding to the information which has been

processed by the MAPI . It is standard for window operation system (see description of the

preferred embodiments, page 29, lines 9-14).

Claim Rejections - 35 USC § 102

32.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

33.   Claims 18, 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Frantz

(U.S.Patent No.6,003,070).

In the claims 18, Frantz discloses an interface device that is either integral or peripheral

to equipment that require monitoring and maintenance; comprises:

- transmitting information from a device (the equipment may be a PBX or ACD, by may include any of type of equipment) to a computer (the interpreter 16) associated within the device (the types of equipments), the device being a business office device including a processor (see col.2, lines 15-38, col.4, lines 10-40);

- processing the information by a device driver within the computer; and transmitting, by the computer, an electronic mail message corresponding to the information (see col. 4, lines 44-50, col.5, lines 1-67).

34.   In the claim 40, Frantz discloses an interface device that is either integral or peripheral to equipment that require monitoring and maintenance; comprises:

- transmitting information from a device (the equipment may be a PBX or ACD, by may include any of type of equipment) to a computer (the interpreter 16) associated within the device (the types of equipments), the device being a business office device including a processor (see col.2, lines 15-38, col.4, lines 10-40);

- processing the information by a device driver within the computer; and transmitting, by the computer, an electronic mail message corresponding to the information (see col. 4, lines 44-50, col.5, lines 1-67).

(11) *Response to Argument*

As to claims 1, 23, in appeal brief page 4, lines 11-19, in appeal brief page 5, lines 1-18, are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kuwabara in view of McCormick.

The Applicant alleges that "it is evident that there is not disclosed in McCormick et at the determination of whether the message which has been received is for a device".

The Applicant argument is not persuasive. Clearly, Kuwabara disclose a title (characteristic of the e-mail) may be in the subject line of the e-mail message (see col.6, lines 6-8, a title for the message such as "inspection program", indicating that this message is about inspection program for the device). Kuwabara does not specifically disclose automatically detecting the characteristic of the e-mail. However, it is well known in the art of automatic email processing to detect a characteristic of the e-mail (see McCormich et al.., abstract, detecting name and character string of the e-mail) in order to automatically route the e-mail or to perform programed action. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have Kuwaba's system detect characteristic of the e-mail in order to automatically detect e-mail directed to control of business office device because it would have enabled remote diagnostic of the business machine automatically via electronic mail message.

As to claims 2, 24, in appeal brief page 5, lines 19-21, in appeal brief age 6, lines 1-12, are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kuwabara in view of McCormick.

The Applicant alleges that "Mc Cormick and Kuwabara could be combined does not disclose determining whether the message is for a device , or whether the message which has been received has a user of the computer as an end recipient".

The argument of claims 2, 24 is not persuasive for the same reason as for claims 1 and 23 above.

As to claim 47, in the appeal brief pages 6, lines 19-21, in the appeal brief page 7, lines 1-14, is rejection under 35 U.S.C. 103 (a) as being unpatentable over the combination of Kuwabara-McCormick in view of Miyachi.

The Applicant alleged that "this make no sense as would ever substitue a general purpose computer with receive e-mails with a printer or scanning device.

The Applicant argument is not persuasive. The combined system of Kuwabara and of McCormick does not disclose the business device being at least one of generate an image on a recording medium, and scan an image on a recording medium. The business office device having at leat one of generate an image on recording medium, and scan an image on a recording medium is well known in the art (see Miyachi, col. 2, lines 31-32, a peripheral device is pronter, scanner, fax, computer). The type of business device being used would have been design choice because the method of remote diagnostic of the business device via

electronic mail message would have been applicable to any business devices (printer, scanner, fax, computer etc.).

As to claims 18, 40, in appeal brief page 7, lines 14-21, requires the use of a device driver.

The applicant alleged that "no prior art discloses or suggest the use of device driver". The applicant argument is not persuasive. The applicant argued that "A device driver is a known term of art and include software that convert general input/output instructions of the operating system to message that the device type can understant". Frantz col.4, lines 37-47 teaches the interpreter (device driver) convert e-mail from the technician such as command , diagnosis instruction, repair etc. into data "language" that the type of device can understand). Clearly, the interpreter of Frantz meet the definition of "device driver" as claimed.

For the above reason, it is believed that the rejection should be sustained. Respectfully submitted.

Chuong Ho
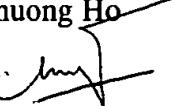
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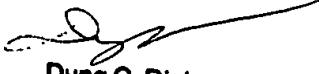
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